

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 10/736,293
Filing Date: 12/16/2003
Applicant(s): Mustansir Banatwala,
Stephen J. Foley and
Alexander Kordun
Entitled: MANAGING EXTERNAL DATA SOURCES IN A
DISCUSSION FORUM RESOURCE
Examiner: Maceeh Anwari
Group Art Unit: 2109
Attorney Docket No.: LOT920030103US1 (7321-039U)

REPLY BRIEF

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Commissioner for Patents
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Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated July 25, 2008.

The Examiner's response to Appellant's arguments submitted in the Appeal Brief of May 16, 2008, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellant relies upon the arguments presented in the Appeal Brief of May 16, 2008, and the arguments set forth below.

On pages 5 through 6 of the Appeal Brief, Appellants expressed frustration that throughout the prosecution of Appellants' patent application, Examiner failed to address Appellants' arguments and instead set forth wild statements of law without reciting a single shred of legal support for Examiner's theories. Specifically, Appellants stated,

At the outset, Applicant notes that the Examiner has failed to cite any case law that supports the Examiner's position. The Examiner's role is to apply the law, not to make law; and thus, unless the Examiner can support the Examiner's legal conclusion with case law, Applicant submits that the Examiner has improperly attempted to establish new law.

In this regard, the Examiner cites no legal support for a "software per se" test. The Examiner states that because the "present invention can be realized in hardware or software or a combination thereof", the claims of the Applicants fail to meet the statutory requirement. This is an absurd statement of the law as applied to the facts. In that an invention can be embodied within a computing platform of software and hardware components does not automatically render a claim invalid under 35 U.S.C. § 101 as recognized by the Court of Appeals for the Federal Circuit.

Rather, as the Court of Appeals for the Federal Circuit has already set forth as recently as in In re Comiskey, 2007 WL 2728361 (Fed. Cir. Sept. 20, 2007), a claim reciting an algorithm or abstract idea can state statutory subject matter if, as employed in the process, it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter. The Applicants already have clearly established that postings relating to externally sourced data can be posted in another, externally disposed discussion forum so as to perform the requisite transformation. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1, 2 and 4 through 13 under 35 U.S.C. § 101.

In response, Examiner argues on page 9 of the Examiner's Answer,

Claims 1 (and its dependents 2 and 4) reads, a discussion forum resource comprising: a topic thread and a data aggregator, all of which are interpreted as being software hence lacking a hardware component. In order for a claim to fall within a statutory category there would have to be necessary physical articles or objects to constitute a machine or a manufacture. The same rationale applies to claim 13; therefore the claims fail in Claims 1 (and its dependents 2 and 4) reads, a discussion forum resource comprising: a topic thread and a data aggregator, all of which are interpreted as being software hence lacking a hardware component. In order for a claim to fall within a statutory category there would have to be necessary physical articles or objects to constitute a machine or a manufacture. The same rationale applies to claim 13; therefore the claims fail in possessing a physical component to constitute a machine or a manufacture rendering them non-statutory under U.S.C. § 101.

Thus, as before Examiner continues to support Examiner's rejections without a single recitation of law and represents clearly reversible error.

Despite Examiner's unwillingness to vest effort in addressing the rejection at hand, Appellants further direct the attention of the Honorable Board to M.P.E.P. 2106(IV)(C)(2) which sets forth

A claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it:

- (A) "transforms" an article or physical object to a different state or thing; or
- (B) otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

Of substantial importance, M.P.E.P. 2106(IV)(C)(2)(1) provides in pertinent part, "USPTO personnel first shall review the claim and determine if it provides a transformation or reduction of an article to a different state or thing. If USPTO personnel find such a transformation or reduction, USPTO personnel **shall end the inquiry and find that the claim meets the statutory requirement of 35 U.S.C. 101.**" Applicants have clearly established that the claimed discussion forum resource of claim 1 includes a data aggregator that executes in a computing platform and is coupled to at least one topic thread. The data aggregator as claimed is configured to manage externally sourced content in the at least one topic thread. Accordingly, claim 1 on its face transforms externally sourced content in a topic thread in a data aggregator executing in a computing platform. Thus, claim 1 recites statutory subject matter.

On page 7 of the Appeal Brief, Appellants argued in respect to Examiner's rejections under 35 U.S.C. § 112, first paragraph,

In the Final Office Action, the Examiner stated, "The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time application was filed had possession of the invention." Namely, the Examiner objected to the introduction of the term computing platform as a claim limitation. Yet, it is plain to see from Figure 1 that a computing platform is present in the form of the collaborative host 130. **The Examiner has provided absolutely no factual or legal support for the Examiner's assertion that the one skilled in the art would not recognize the equivalence of the picture of a computing platform with the text "computing platform".** Because Figure

1 provides ample support for the equivalence, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1, 2 and 4 through 13 under 35 U.S.C. § 112, first paragraph.

In response, on page 10 of the Examiner's Answer, Examiner argued,

Claims 1- 2, 4 and 13 recite language such as "adapted to" or 'configured to". These terminologies render the claim indefinite as the scope of the claim becomes open ended, undeterminable, and/or based upon intended use. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitations.

It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (8) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses
- (E) "configured to" clauses.

Again, as was the case before, Examiner provides absolutely no legal support for Examiner's position and instead "makes up the law" to suit Examiner's purpose. Further, Examiner's own theories fly in the face of well-established principals of claim construction including the limiting effect of terms such as "configured to" and "wherein". Examiner's arguments are completely misplaced as there is nothing ambiguous about the phrase "configured to" which means simply that something has been arranged in a certain way in order to achieve a certain result--this language has always been held to be limiting and literally thousands of examples of issued patents can be referenced that utilize this precise language.

In any case, Examiner's so-called rationale for the rejection of claims 1, 2 and 4 through 13 under 35 U.S.C. § 112, first paragraph bear no relationship to the enablement requirement of 35 U.S.C. § 112, first paragraph. Rather, under 35 U.S.C. § 112, first paragraph, the specification of the patent must teach those skilled in the art how to make and use the claimed

invention without undue experimentation.¹ Additionally, the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the disclosure.² However, enablement is also not precluded even if some experimentation is necessary, although the amount of experimentation needed must not be unduly excessive.³

The factual inquiry for determining whether a specification provides sufficient written description for the claimed invention is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.⁴ An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.⁵ Examiner, however, raises no question as to the sufficiency of Appellants' specification and only calls into question the use of the term "computing platform" and now, on a new ground of rejection, the use of the term "configured to". Examiner has erred (badly) in this regard.

Finally, in response to Appellants' arguments on page 8 of the Appeal Brief in which Appellants stated, "Nowhere in Fredell is there a teaching directed to externally sourced content comprise postings from another discussion forum resource as expressly required by claim 1", Examiner argued on page 11 of the Examiner's Answer,

[E]ven if claims 1- 2, 4 and 13 do not recite intended use language the Examiner respectfully disagrees that Fredell does not disclose those limitations. The appellant uses the terms discussion forum resource (and not a discussion forum), therefore Fredell, discloses this limitation through:

¹ *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997)

² *Id.*

³ *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986).

⁴ *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

⁵ *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)

"FIG. 4 shows an exemplary web page 100 including a plurality of clickable icons [discussion forum resources], e.g., icons 101-106 representative of functionality provided by the system. Web page 100 further includes a user navigator window 108 including a plurality of clickable hyperlinks [discussion forum resource which could be a reference to another document in a different/external domain] 110. Icon 101 provides access to an on-line "Document Vault"

Thus, Examiner implicitly construes the essential claim term "discussion forum resource" as "hyperlinks". Yet, the plain meaning of "discussion forum resource" is a "computing resource that is a discussion forum". Of note, during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification."⁶ The Federal Circuit's en banc decision in Phillips v. AWH Corp.⁷ expressly recognized that the United States Patent and Trademark Office employs the "broadest reasonable interpretation" standard.

Paragraph [0007] of Appellants' specification is reproduced herein as follows:

[0007] The discussion forum resource has become a ubiquitous component of collaborative environments. A keyword searching of the Web space literally can produce tens of thousands of resulting links to discussion forums disposed about the World Wide Web. Despite the diversity of topic threads in Web space, it will not surprise the skilled artisan to note that substantial topic overlap exists between different discussion resources. Yet, as a collaborator, to participate in posting and viewing comments about different topic threads having similar topical content in different discussion resources can be time consuming and terribly inefficient. To that end, a substantial deficiency remains in the collaborative environment in respect to the management of topically related postings in a discussion forum resource.

Thus, by reference to Paragraph [0007], it is clear that "discussion forum resource" is used by Appellants consistently with the ordinary meaning of a "discussion forum resource". Accordingly, Examiner in equating the claim term "discussion forum resource" to a "hyperlink" has erred in applying a broader than reasonable claim construction to the essential claim term "discussion forum resource".

⁶ M.P.E.P. 2111.

⁷ 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).)

It follows from Examiner's inappropriate claim construction that Examiner has failed to locate within Fredell an identical teaching to that of Appellants' claims 1, 2 and 4 through 13. However, the factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.⁸ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.⁹ Absence from an allegedly anticipating prior art reference of any claimed element negates anticipation.¹⁰

For the reasons set forth in the Appeal Brief, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. §§ 101, 102(b) and 112, first paragraph.

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Respectfully submitted,

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⁸ In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997) ("To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently"), In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

⁹ See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

¹⁰ Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571 (Fed. Cir. 1986)(emphasis added).